



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,393	08/14/2001	Jean Billieres	34539PCTUSAA-070337.0272	9163

21003 7590 10/10/2003

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,393

Applicant(s)

BILLIERES, JEAN

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 7-14, 16, 17 and 19-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-21, drawn to a tire, classified in class 152, subclass 450.
 - II. Claims 22-28, drawn to a process for making the tire, classified in class 156, subclass 123.
 - III. Claim 29, drawn to a process for making a one-face calendered ply, classified in class 156, subclass 178.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II-III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the ply is formed by winding the reinforcement elements individually coated with the rubber mix B or B₁ directly on the tire blank before application of the exterior rubber layer A or A₁ rather than by making the one-face calendered ply intermediate product.
3. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all the limitations of the subcombination are not required in the combination.

Art Unit 1733

The subcombination has separate utility such as a process for making a one-face calendered ply for reinforcing other rubber composite articles such as hoses, drive belts, or conveyor belts.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. If Invention I is elected, a further election of species is required as set forth below.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: a tire whose at least one reinforcing ply is either in the carcass with the composition and properties of the first layer A or A₁ being identical to those of the coating mix B or B₁ or in the carcass with the composition and properties of the first layer A or A₁ being different from those of the coating mix B or B₁ or in the acute angle crown reinforcement with the composition and properties of the first layer A or A₁ being identical to those of the coating mix B or B₁ or the circumferential crown reinforcement or the beads or the sidewalls (specification paragraphs 0009 and 0010).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

Art Unit 1733

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. If Invention II is elected, a further election of species is required as set forth below.

8. This application contains claims directed to the following patentably distinct species of the claimed invention: a process for making the tire wherein the at least one reinforcing ply is either in the carcass and formed by applying the one-face calendered ply on the tire blank and then applying the second calendering layer C on the one-face calendered ply or in the carcass and formed by applying the second calendering layer C on the tire blank and then applying the one-face calendered ply on the second calendering layer C or in the acute angle crown reinforcement (specification paragraphs 0010, 0012, and 0015).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

Art Unit 1733

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Anthony Giaccio on December 4, 2002 a provisional election was made with traverse to prosecute the invention of Group I and the species wherein the at least one reinforcing ply is in the carcass with the composition and properties of the first layer A or A₁ being identical to those of the coating mix B or B₁, claims 1-6, 15, and 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-14, 16, 17, and 19-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

10. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

Specifically, the filing date of this application is just under 30 months from the foreign priority date but there is no evidence of record that Chapter II was requested in parent

Art Unit 1733

PCT/EP00/01189 in order to maintain pendency of the parent application for 30 months from the foreign priority date (see MPEP 1895).

11. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

12. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Tire with Specified Reinforcing Ply.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 8 and claim 4 line 6 "variable" should be changed to -- varied -- to eliminate vague and indefinite language (otherwise it is not clear whether or not the composition and properties are required to be varied in the claims).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit 1733

16. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costa pereira et al. (6,199,612 B1) or its equivalent European Patent Application 0 869 015 A1.

The only difference between the claimed tire and the Costa Pereira et al. tire is that the reference is silent as to whether or not the carcass cords have incorporated therein an individual rubber coating (see entire document), however it is notoriously well known to provide such a coating to improve cord adhesion to the adjacent rubber layers, especially when the adjacent rubber layers are the same rubber as the rubber coating. It would therefore have been obvious to one of ordinary skill in the art to provide such notoriously well known individual rubber coating in the carcass cords of the Costa Pereira et al. tire being the same rubber as the conventional low modulus inner adjacent rubber layer in order to improve cord adhesion to the adjacent rubber layers.

Allowable Subject Matter

17. Claims 3-6, 15, and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Method claims 22-28 have not been rejoined at this time because they do not incorporate all of the limitations of a tire claim allowable in substance.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit 1733

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

Adrienne Johnstone

September 30, 2003

A handwritten signature in black ink that reads "Adrienne C. Johnstone". The signature is written in a cursive, flowing style with a large initial 'A' and a long, sweeping underline.